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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,379	02/28/2002	Akemi Hirotsune	H&A-108	1244

7590

10/04/2005

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EXAMINER

AUGUSTIN, EVENS J

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/084,379

Applicant(s)

HIROTSUNE ET AL.

Examiner

Evens Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-6 and 8-16 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This is in response to an amendment file on July 28th, 2005 for letter for patent filed on February 28th, 2002. In the amendment, claim 7 has been cancelled. Claims 12 and 14 have not been amended. Claims 1-6 and 8-16 are pending in the letter.

Response to Arguments

1. Applicant's arguments filed July 28th, 2005 have been fully considered but were not persuasive enough to change the office's previous position with regard to the current application and the prior arts.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant argues that the prior arts fail to teach data being recorded in a defective area from an optical medium (CD-RW and recordable DVD). During examination, the claims must be interpreted as broadly as their terms reasonably allow. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Claim 1, giving its broadest reasonable interpretation during examination, the USPTO interprets the claim as having the ability to record new data on a prerecorded optical medium. According to well-established definition of formatting (Microsoft Dictionary, Third Edition), it is to prepare for use by organizing its storage space into a collection of data "compartments", each of which can be located by the operating system so that data be sorted and retrieved. When a disk is formatted, any preexisting information on it is lost. According to Sasaki et al., during the recording and reproduction process, the optical medium is

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formatted (column 12, lines 19-25). Therefore, any prerecorded data that was shipped with the optical medium can be erased and new information can be recorded accordingly. Additionally, the combined user/file management area and spare area is divided into a plurality of zones (column 4, lines 20-23). When the recording medium is divided into a plurality of zones, the defective sector detected in the file management/user area and the replacing sector are located in the same zone (column 23, lines 25-30).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (U.S 6,742,147), in view of Dimitri et al. (U.S 6,574,424).

As per claims 1-10 and 12-16, Sasaki et al. discloses a recording medium, method and apparatus which includes:

- A recording medium/optical disk such as a DVD-RAM (column 8, line 26) with a disk information area, a user area including a plurality of sectors (recording limiting area) and a spare area, capable of storing information. The recording or reproduction is done on a sector-by-sector basis (column 8, lines 27-28). The spare area is used when one of the

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other areas is considered defective (column 4, lines 1-5) or an error has occurred in reading the sector address (column 13, lines 14-16)

- Displaying information on a screen (column 7, lines 55-57)
- File allocation table within the data recording area (column 9, lines 4-6), containing location information, indicating locations of files and directories in the file data area and indicating locations of empty areas (column 9, lines 20-22)
- Detecting a defective sector included in the user area (column 5, lines 24-25)
- The file allocation table is read from the optical disk by recording and reproduction apparatus before recording (column 16, lines 1-5). An area is considered defective if an error has occurred in reading the sector address (column 13, lines 14-16)

Sasaki et al. does not teach a recording medium with pre-recording data, such as advertisement. However, Dimitri et al. teaches a method for storing commercials on DVDs (column 6, lines 18-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk. It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk because it would reduce the costs involved in making the disks (column 2, lines 4-6), and it would provide a new platform to advertise to the captive customers of optical disks.

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (U.S. 6,742,147) and Dimitri et al. (U.S. 6,574,424), in view of Ueseka et al. (US 6,044,157).

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As per claim 11, Sasaki et al. and Dimitri et al.'s inventions have previously been disclosed above.

Sasaki et al. and Dimitri et al. did not explicitly describe a method/system in which data recorded on an optical disk is encrypted. However, Ueseka et al. describes a method/system that teaches encrypted data from an optical disk such as DVD (column 20, lines 11-12). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to encrypt pre-recorded data on an optical disk because it prevent piracy of the disks (column 4, line 56) by enabling the prohibition of illegal copies and malfunctions to be achieved (column 6, lines 51-52).

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
September 20, 2005
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James J. Trammel
Primary Examiner
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